



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/862,424	05/23/2001	Victor M. Markowitz	4010US (111944-0015)	8455
27189	7590	04/27/2005	EXAMINER	
PROCOPIO, CORY, HARGREAVES & SAVITCH LLP			LY, CHEYNE D	
530 B STREET			ART UNIT	
SUITE 2100			PAPER NUMBER	
SAN DIEGO, CA 92101			1631	

DATE MAILED: 04/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	Application No. 09/862,424	Applicant(s) MARKOWITZ, VICTOR M.	
	Examiner Cheyne D. Ly	Art Unit 1631	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 05 April 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 1,16-21,24-28,35 and 37-41.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
 13. ☒ Other: See Continuation Sheet.

Continuation of 3. NOTE: Applicant has proposed to introduce the limitation of "fragment index" to claims 1, 16, 21, 24, 35, and 37, and the limitation of "clinical data" to claims 1, 21, and 35, which raise new issues that would require further consideration and/or search. Applicant has proposed to replace the limitation of "annotation" with the new limitation of "fragment index." It is noted that the respective limitations are directed to different type of data in regard to what each limitation encompasses.

Continuation of 11. does NOT place the application in condition for allowance because:

Claims 1, 16-21, 24-28, 35, and 37-41 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Ermolaeva et al. (1998).

This rejection is maintained with respect to claims 1, 16-21, 24-28, 35, and 37-41, as recited in the previous office action mailed December 01, 2004.

RESPONSE TO ARGUMENTS

Applicant has submitted "Exhibit A" to overcome the instant prior art rejection which is not persuasive because of the non-entry of the claim amendment. "Exhibit A" is based on the newly amended claims and the claim as whole requires new consideration and search, therefore, the amendment as a whole will not be entered.

Specific to the argued limitation of "separate databases" and "links between the gene expression...the separate databases", Ermolaeva et al. describes the ArrayDB system wherein gene expression data is stored in a relational database comprising a plurality of tables (Abstract etc. and page 20, column 1, Box 1). ArrayDB provides hyperlinks to other relational databases such as dbEST, GenBank, UniGene, or KEGG (page 21, column 1, lines 5-16) which anticipates the argued limitations as previously cited.

Specific to the argument directed to the proposed limitation of "clinical data", Applicant's argument is not persuasive because of the non-entry of the claim amendment. Further, the new limitation of "clinical data", which is an optional limitation, would not cause the claim 1, as a whole, to overcome the prior art, if said new limitation is entered. It is noted that the prior art anticipates one or more of the optional limitations listed in claim 1.

Specific to the "user query limitation", Ermolaeva et al. describes the Web-based user interface to the ArrayDB system that supports database queries and allows the retrieval of distinct types of information ranging from clone data to intensity data to analysis results. ArrayDB provides hyperlinks to other databases such as dbEST, GenBank, UniGene, or KEGG (page 21, column 1, lines 5-16).

Continuation of 13. Other: On page 9, Applicant argues that the final rejection is premature. Applicant's argument is not persuasive because the claim amendment, filed August 30, 2004, introduced the new limitation of "expression data is obtained from microarrays" that necessitated the withdrawal of the previously cited prior rejections in the Office Action, mailed February 25, 2004. Further, said claim amendment necessitated the prior art rejection in the previous Office Action, mailed December 01, 2004.

CAL
4/20/05

Ardin H. Marschel 4/24/05
ARDIN H. MARSCHEL
PRIMARY EXAMINER